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10/567,387

02/07/2006

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EXAMINER

SMALLEY, JAMES N

ART UNIT

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3781

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/567,387 | Applicant(s) PHILLIPS, ROBERT | |
| | Examiner JAMES N. SMALLEY | Art Unit 3781 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-19 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3781

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 9, the claim limits the wing members "...hinged in opposite senses on operation of the same." However, the claim depends from claim 1, wherein only one wing member has been limited.

Regarding claim 14, the claim limits counterpart engagement elements which engage one another "...to lock the wing members in the hinged configuration..." However, the claim depends from claim 1, wherein again only one wing member has been limited.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 14, and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3781

Claims 9 and 14 recite "the wing members"; however, they each depend from claim 1, where the wing member is introduced in the singular. Thus, there is insufficient antecedent basis for this limitation in the claim.

Regarding claim 17, the limitation "where integrally formed" is not grammatically correct, and therefore, it is not clear what is being integrally formed.

Claim 18 is also unclear, as the phrase "where vacuum formed" is not grammatically incorrect.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-8, 10-11, and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Portman et al. US 5,657,898.

Portman '898 teaches a lid comprising a flange (45) for attachment to a container body, an aperture (20) through which the drawstring of a teabag is freely slidable, and at least one wing member (25) which is hinged to body section which is capable of squeezing a teabag in a raised position.

More specifically regarding claim 1, Examiner notes that the wing is a tear-out flap; however, the flap is physically capable of being torn to define the flap, inverted, i.e. rotated underneath the lid, and then applying the lid to the container. In this position, the flap could engage the teabag in a raised position. Examiner notes that while this not the ordinary use of the lid, it meets all physical limitations of the first claim.

Regarding claim 5, Examiner notes the invention is claimed for use of a beverage bag, and therefore, the prior art must only be capable of being used in the intended manner. In the instant case, as the lid of Portman '898 is designed for use with tea bags having tabs on the draw string, the reference properly anticipates the invention.

Art Unit: 3781

Regarding claim 6, Examiner notes the raised areas immediately adjacent the perforated lines (26) on the opposite side of the wing member/lift tab (25) comprise a spout.

Thus regarding claim 7, the wing member is operable to form a spout because it tears away, forming a drink opening within the raised structures identified above with regard to claim 6.

Regarding claim 8, the wing member is hinged as shown in figure 2.

Regarding claim 10, the lid is torn along perforated lines (26) and then pivoted about an integral hinge.

Regarding claim 11, the lift tab/wing member (25) has a central recessed middle portion, as seen in figure 1.

Regarding claim 15, Examiner notes figure 1, whereby the slit (20) which receives the drawstring comprises intersecting cuts, one of which is read to be the aperture of claim 1, and the other of which is read to be the drawstring locking element, as the string could be pulled into this slit and frictionally locked in place.

Regarding claim 16, the lid comprises an upstanding wall member (located above 45), and the closure member is read to be the lift tab/wing member (25) which also includes the hinge which is a portion of the body section, and functions to close the opening created in the lid.

Regarding claim 17, Examiner notes the lid is integrally formed in one piece.

Regarding claim 18, Examiner notes that although such lids as the one taught by Portman '898 are typically formed in vacuum molding processes, the claim is drawn to a manufacturing limitation within the scope of an apparatus claim. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

Art Unit: 3781

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 6,488,170 in view of Portman et al. US 5,657,898.

Johnson '170 teaches a lid comprising a flange (34) for attachment to a cup, a body unit (31, 35, 36, etc.), and at least one wing member (40).

The reference, as applied, fails to teach an aperture through which a drawstring from a beverage bag unit is slidable.

Portman '898 teaches an aperture (20) in a lid for a beverage cup, in order to hold a tea bag and allow a user to steep the tea, consume the beverage, and dispose of the container, without handling the tea bag.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lid of Johnson '170, providing an aperture, such as that taught by Portman '898, motivated by the benefit of allowing a user to steep tea and dispose of the container without handling the tea bag. Furthermore, Examiner notes the BPAI has held the question is not whether the prior art devices can be physically combined, but whether a person of ordinary skill in the art would have found it obvious to combine different features or elements of known devices in a predictable way. *See Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983): "There is a distinction between trying to physically combine the two separate apparatus disclosed in two prior art references on the one hand, and on the other hand trying to learn enough from the disclosures of the two references to render obvious the claims in suit. ...Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference." Thus, it would be

Art Unit: 3781

obvious to locate the opening somewhere, which does not interfere with the function of the invention, such as within the central hub (31).

Furthermore regarding claim 1, the wing members (40) of Johnson '170, as modified, are capable of being used in the intended manner, i.e. they are capable of squeezing and/or holding a tea bag, as they are hinged, and to be depressed inwardly into the container. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 2, the lid of Johnson '170 comprises multiple wing members (40).

Regarding claim 3, the lid of Johnson '170 forms a liquid tight seal with the container.

Regarding claim 4, the aperture in the lid of Johnson '170, as modified, is sized such that a tea bag can move freely within.

Regarding claim 5, the hole appears large enough that the tab on the tea bag could be rolled up into a thin tube, and passed therethrough.

Regarding claim 6, the raised portions (35, 36) about the openings of Johnson '170 form a spout.

Regarding claim 7, the wing member (40) is operable to form a spout as it is pressed in, creating an opening within the spout (35, 36).

Regarding claims 8-9, the wing members are hinged, as they are consistently referred to in the disclosure as "tabular hinged drinking regions."

Regarding claim 10, it would have been obvious to modify the intended breaking lines (46, 47), forming them of perforations, motivated by the benefit of enhancing their ability to break along this location.

Regarding claim 11, the wing members are recessed with respect to the top surface of the lid, as shown in figures 2A and 2B.

Regarding claim 15, the aperture as provided by Portman '898 comprises intersecting cuts, one of which is read to be the aperture of claim 1, and the other of which is read to be the drawstring locking element, as the string could be pulled into this slit and frictionally locked in place.

Art Unit: 3781

Regarding claim 16, the lid comprises an upstanding wall member (33).

Regarding claim 17, Examiner notes the lid is integrally formed in one piece.

Regarding claim 18, Examiner notes that although such lids as the one taught by Johnson '170 are typically formed in vacuum molding processes, the claim is drawn to a manufacturing limitation within the scope of an apparatus claim. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

Regarding claim 19, the tea bag is not positively claimed, and the device of Johnson '170 must only be capable of being used with a tea bag.

10. Claims 1-4, 6-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 6,488,170 in view of Dart et al US 4,412,629.

Johnson '170 teaches a lid comprising a flange (34) for attachment to a cup, a body unit (31, 35, 36, etc.), and at least one wing member (40).

The reference, as applied, fails to teach an aperture through which a drawstring from a beverage bag unit is slidable.

Dart '629 teaches a vent opening (39) in a lid, which allows for air to enter the container while liquid exits, which is known to promote laminar flow.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lid of Johnson '170, providing an aperture, such as that taught by Dart '629, motivated by the benefit of promoting laminar flow.

Furthermore regarding claim 1, the wing members (40) of Johnson '170, as modified, are capable of being used in the intended manner, i.e. they are capable of squeezing and/or holding a tea bag, as

Art Unit: 3781

they are hinged, and to be depressed inwardly into the container. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, the vent opening is capable of being used in the intended manner, i.e. it is capable of receiving the drawstring of a tea bag.

Regarding claim 2, the lid of Johnson '170 comprises multiple wing members (40).

Regarding claim 3, the lid of Johnson '170 forms a liquid tight seal with the container.

Regarding claim 4, the aperture in the lid of Johnson '170, as modified, is sized such that a tea bag drawstring can move freely within.

Regarding claim 6, the raised portions (35, 36) about the openings of Johnson '170 form a spout.

Regarding claim 7, the wing member (40) is operable to form a spout as it is pressed in, creating an opening within the spout (35, 36).

Regarding claims 8-9, the wing members are hinged, as they are consistently referred to in the disclosure as "tabular hinged drinking regions."

Regarding claim 10, it would have been obvious to modify the intended breaking lines (46, 47), forming them of perforations, motivated by the benefit of enhancing their ability to break along this location.

Regarding claim 11, the wing members are recessed with respect to the top surface of the lid, as shown in figures 2A and 2B.

Regarding claim 16, the lid comprises an upstanding wall member (33).

Regarding claim 17, Examiner notes the lid is integrally formed in one piece.

Regarding claim 18, Examiner notes that although such lids as the one taught by Johnson '170 are typically formed in vacuum molding processes, the claim is drawn to a manufacturing limitation within the scope of an apparatus claim. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a

Art Unit: 3781

product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

Regarding claim 19, the tea bag is not positively claimed, and the device of Johnson '170 must only be capable of being used with a tea bag.

Allowable Subject Matter

11. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3781

/Anthony D Stashick/
Supervisory Patent Examiner,
Art Unit 3781

/James N Smalley/
Examiner, Art Unit 3781